REMARKS

In the Office Action that was mailed on November 28, 2003, claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Domenikos et al. (U.S. Patent No. 5,838,916) ("Domenikos"); claims 3-5 were rejected under 35 U.S.C. § 102(e) as being anticipated by Wolff (U.S. Patent No. 6,185,601) ("Wolff"); and claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Domenikos in view of Wolff. The foregoing rejections are respectfully traversed.

Claims 1-5 are pending in the subject application, of which claims 1, 3, and 4 are independent claims.

Foreign Priority:

The examiner has not yet acknowledged the Applicant's claim for foreign priority and submission of a certified copy of the foreign priority document, which were filed on March 16, 2001. The Applicant respectfully requests that the examiner acknowledge the same.

Amendments to the Claims:

Claims 1-5 are amended herein, and new claims 6-8 are added herein. Specifically, Care has been exercised to avoid the introduction of new matter. Support for new claims 6-8 may be found in the Specification at page 12, lines 17-20 and page 21, lines 15-19. Support for the amendments to claims 1-5 may be found in the Specification at page 12, line 27 – page 13, line 4, page 15, line 24 – page 16, line 24, and Figure 1.

Rejections of the Claims:

Differences Between the Claimed Invention and the Cited References:

One of the advantages of the client-server system of the present invention is that the input/output processing is done on the server side instead of the client side, eliminating the need for a hard disk on the client and reducing the possibility of failure associated with a hard disk. (Specification, p. 14, line 16 – p. 15, line 1). In the present invention, the POS software, which is located on the server, controls an I/O device that is connected to the client via a virtual I/O port on the server and a device handler on the client. (Specification, p. 12, line 27 – p. 13, line 4; p.

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15, line 24 – p. 16, line 24; Fig. 1). Independent claim 1 (as amended herein) recites the software and virtual I/O port on the server and the device handler on the client. Independent claim 3 (as amended herein) recites the software and virtual I/O port on the server. Independent claim 4 (as amended herein) recites the device handler on the client.

Taken individually or in combination, neither Wolff nor Domenikos discloses or suggests the device handler, virtual I/O port, and server software of the claimed invention. Specifically, Domenikos discusses a client/server system in which a client sends (redirects) a remote I/O request to a server that is connected to the remote I/O device. (Domenikos, col. 19, lines 7-36; Fig. 6). In Domenikos, the remote I/O requests correspond to requests for things like printers, serial ports, mail slots, etc., that are connected to a remote server, not the client itself. (Domenikos, col. 19, lines 10-14). Domenikos does not disclose or suggest that the I/O device is coupled with the client, as recited in independent claims 1, 3, and 4 of the subject application (as amended). In addition, because the remote I/O request in Domenikos applies to something that is not coupled with the client, Domenikos does not require, nor does it disclose or suggest the device handler and virtual I/O port of the claimed invention.

In addition, Wolff discusses a network that rebalances itself to optimize throughput by migrating client I/O requests from over utilized pathways to under utilized pathways. (Wolff, Abstract). Client load rebalancing refers to the ability of a client, enabled with particular processes, to re-map a path through a plurality of nodes to a resource. (Wolff, col. 4, lines 52-55). Two kinds of clients are discussed in Wolff, normal (unaware) clients, and aware clients. (Wolff, col. 5, lines 18-20). Normal clients cannot initiate the client load rebalancing process; aware clients can. (Wolff, col. 5, lines 35-38).

In Wolff, a client or a server may make an I/O request. (Wolff, col. 52, lines 47-59). The examiner cited to the subroutine illustrated in Figure 10G as anticipating the claimed invention. (Office Action, p. 3-5). In Figure 10G, operation 1312 determines whether a client or a server generated the I/O request. (Wolff, col. 52, lines 53-55; Fig. 10G, process 1312). If an aware client generated the I/O request, the subroutine continues at process 1320, but if an unaware client or a server generated the I/O request, the subroutine ends. (Wolff, col. 52, lines 55-59; Fig. 10G, processes 1312-1320). Therefore, the load balancing discussed at processes 1322-1328 of Wolff does not occur when an unaware client or a server generates an I/O request. Further, processes 1322-1328 of Wolff are only carried out when an aware client, which contains application module 196 for generating an I/O operation, generates the I/O request.

(Wolff, col. 12, lines 44-47). Consequently, Wolff's discussion of load balancing is not relevant to the claimed invention, which recites that the I/O request originates at the server, not the client.

Lack of Motivation to Combine the References:

For purposes of the rejection of claim 2, the examiner failed to make a *prima facie* case of obviousness because he did not sufficiently support the motivation to combine the references. Specifically, MPEP § 706.02(j) requires that, to establish a *prima facie* case of obviousness under § 103, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "'The factual inquiry whether to combine the references must be thorough and searching.'" In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The examiner has not presented any evidence why Wolff and Domenikos would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The examiner's sole support for such a combination is that the combination would allow a "clinet/server [sic] system to control and

process all I/O processes for the client in order to balance and reduce the processing time of the client." (Office Action, p. 5) (errors in original). The examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either reference, and the examiner has not presented any actual evidence in support of the same. Instead, the examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

The Applicant respectfully calls the examiner's attention to the fact that all of the following cases are outdated in light of the cases discussed above: In re Fine, In re Jones, Wang Labs. v. Toshiba Corp., Cable Electric Products v. Genmark, In re Sheckler, In re Bode, In re Jacoby, In re Bozek, and In re Prater. The Applicant notes that the examiner's reliance on such older case law would be in error, and the Applicant respectfully requests that the examiner review the case law cited by the Applicant above prior to making a determination on the issue.

Withdrawal of the foregoing rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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